

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

GEISSMANN *et al.*

Appl. No. 09/832,922

Filed: April 12, 2001

For: **Compositions and Methods for
Use in Modulating Immune
System Function**

Confirmation No.: 8471

Art Unit: 1644

Examiner: Huynh, P.N.

Atty. Docket: 1383.0260001/EKS/BJD

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

*Via Hand Carry to Examiner Phuong N. Huynh
Art Unit 1644*

Sir:

In reply to the Office Action dated April 22, 2002 (Paper No. 2), requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-2, 4-5, 10 and 16. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse. The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803. Neither of these criteria has been met; therefore, Applicants respectfully assert that the present restriction requirement is in error. Reconsideration and withdrawal are respectfully requested.

As an initial matter, Applicants respectfully assert that the claims in Groups I-XLVI are closely related in subject matter. As such, a search of one group of claims is likely to encompass subject matter pertinent to the patentability of all groups, particularly since all of the groups have been classified by the Examiner in class 424, subclass 198.1. Moreover, the Examiner has

provided no reasoning as to why, for example, claims 1-2, 4-6, 10 and 16 are each restricted into numerous separate restriction groups (*e.g.*, Groups I and II *both* contain *only* claims 1, 2, 4, 5, 10 and 16, and Groups III-V *all* contain *only* claims 1-2, 4, 6, 10 and 16; this pattern is repeated for numerous other sets of claims throughout the restriction requirement). Indeed, Applicants note that although the present application contains only 37 claims, these claims have been restricted into *46 separate restriction groups* (*see* Paper No. 2 at pages 2-10). The basis of restriction practice is the statutory requirement under 35 U.S.C. § 101 that a patent application be drawn only to one independent and distinct invention. Applicants respectfully submit that restricting the present application into more restriction groups than there are claims pending in the application is improper under the statutes, rules and guidelines for proper restriction. Instead, the Examiner's grouping of claims would seem more appropriate for an Election of Species requirement under MPEP § 809.02(a) (although Applicants respectfully assert that such a requirement would also be improper). Hence, the first requirement for proper restriction -- that the alleged inventions be independent and distinct as claimed -- is not met in the present case.

Similarly, the Examiner has not satisfied the second requirement set forth in MPEP § 803, *i.e.* the Examiner has not shown why a serious burden would be imposed on the Examiner if restriction were not required. The Examiner has not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. Moreover, as noted above, all of the groups have been classified by the Examiner into class 424, subclass 198.1. By definition, then, a search of only this one class and subclass should uncover art relevant to every one of the listed restriction groups. A serious burden therefore has not been established, and "[i]f the search and examination of an entire

application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803.

Thus, neither of the criteria for establishing a proper restriction requirement has been established in the present case. It should be noted that the two requirements set forth in MPEP § 803 are connected with "and;" satisfaction of both criteria therefore is required. Hence, Applicants respectfully assert that for at least these reasons, the present restriction requirement is improper; reconsideration and withdrawal, and consideration of all pending claims, are therefore respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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